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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92058143
Party	Plaintiff Van de Wall B.V.
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Date	01/06/2014
Attachments	AFROJACKS_Amended_Petition_to_Cancel.pdf(967344 bytes )

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re: Registration No. 3,556,451  
Mark: AFROJACKS  
Issue Date: January 6, 2009

VAN DE WALL B.V.

Petitioner,

v.

Cancellation No. 92058143

D-MINOR, INC.

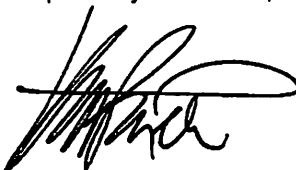
Respondent.

NOTICE OF AMENDED PETITION TO CANCEL

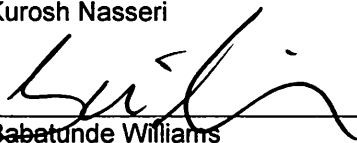
VAN DE WALL B.V., through the undersigned counsel, hereby provides notice of amending its  
Petition to Cancel dated November 1, 2013.

On January 6, 2014, a copy of the Amended Petition to Cancel was sent to: Leslie A. Thompson,  
Esq., of Leslie A. Thompson & Associates, 1629 K Street, NW, Suite 300, Washington, DC 20006.

Respectfully submitted,



By: \_\_\_\_\_  
Kurosh Nasser

By:   
Babatunde Williams

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Attorneys for Petitioner

Dated: January 6, 2014

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re: Registration No. 3,556,451  
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D-MINOR, INC.

Respondent.

AMENDED PETITION TO CANCEL

VAN DE WALL B.V., a corporation organized under the laws of The Netherlands with a place of business at Anke Servaesstraat 2, 3207 HM Spijkenisse, The Netherlands (hereinafter "Petitioner"), believes that its business is being damaged by Registration No. 3,556,451, which issued January 6, 2009, and hereby petitions to cancel the same.

The grounds for cancellation are as follows:

1. On information and belief, D-MINOR, INC. (hereinafter "Respondent") is a corporation organized under the laws of New York with a place of business at 333 East 75<sup>th</sup> Street, Apartment 7F, New York, NY 10021.
2. On information and belief, Respondent is the record owner of U.S. Registration No. 3,556,451 for the AFROJACKS mark, which issued January 6, 2009 for "entertainment services, namely, providing a website featuring audio clips, video clips, musical performances, musical videos, film clips, photographs, other multimedia materials, and providing entertainment information that features audio clips, video clips, musical performances, musical videos, film clips, photographs, and other multimedia materials; on-line journals, namely, blogs featuring entertainment information and audio clips, video clips, musical performances, musical videos, film clips, photographs, and other multimedia materials" in International Class 41. U.S. Registration 3,556,451 was based on an application filed in the U.S. Patent and Trademark Office on March 17, 2008.

3. On information and belief, Respondent is the record owner of U.S. Registration No. 3,556,451 for the AFROJACKS mark by virtue of three assignments recorded in the Assignment Branch on September 9, 2008 at Reel 3849, Frame 0558, on September 16, 2008 at Reel 3854, Frame 0203, and on March 19, 2009 at Reel 3955, Frame 0813.

4. Less than five years have elapsed since the date of registration of Respondent's AFROJACKS mark.

5. Petitioner is a corporation organized under the laws of The Netherlands. Petitioner's sole shareholder is Nick van de Wall, a platinum award-winning recording artist, internationally-renowned disc jockey, and Grammy Award-winning record producer professionally known as "Afrojack" ("the Artist").

6. Petitioner is the owner of common law trademark rights in the AFROJACK mark, used in connection with the Artist's musical sound recordings, audio-visual recordings, music production, live musical performances, disc jockey performances, and a website featuring the Artist's music, videos, photographs, tour information and other multimedia materials and information about the Artist.

7. Petitioner is the owner of application Serial No. 85347734 filed on a use basis under Section 1(a) in the U.S. Patent and Trademark Office on June 16, 2011 for registration of the AFROJACK mark in connection with (i) musical sound recordings and audio-visual recordings, namely, pre-recorded phonograph records, compact discs, digital video discs, and downloadable digital audio files, all featuring music in International Class 9; and (ii) entertainment services, namely, music production, live performances by a musical performer and the playing of live and recorded music by a disc jockey in International Class 41. Citing Respondent's registration for the AFROJACKS mark, the examiner ultimately refused registration of the AFROJACK mark in connection with the aforementioned Class 9 goods and Class 41 services in a Final Office Action dated July 19, 2012 on likelihood of confusion grounds. The application is now abandoned.

8. Petitioner is the owner of application Serial No. 85347743 filed on an intent-to-use basis under Section 1(b) in the U.S. Patent and Trademark Office on June 16, 2011 for registration of the AFROJACK mark in connection with clothing, namely, shirts, pants, shorts, jackets, sweatshirts, sweaters, T-shirts, hats, swimwear and undergarments, and in connection with footwear and headwear in International Class

25. Citing Respondent's registration for the AFROJACKS mark, the examiner ultimately refused registration of the AFROJACK mark in connection with the aforementioned Class 25 goods in a Final Office Action dated August 8, 2012 on likelihood of confusion grounds. The application is now abandoned.

9. Petitioner is the owner of application Serial No. 86108564 filed on a use basis under Section 1(a) in the U.S. Patent and Trademark Office on November 1, 2013 for registration of the AFROJACK mark in connection with (i) musical sound recordings and audio-visual recordings, namely, pre-recorded phonograph records, compact discs, digital video discs, and downloadable digital audio files, all featuring music in International Class 9; and (ii) entertainment services, namely, music production, live performances by a musical performer and the playing of live and recorded music by a disc jockey; entertainment services, namely, providing downloadable and non-downloadable recorded music, non-downloadable musical videos, related video clips, photographs, tour information, event information, and other multimedia materials and entertainment information about a musical artist and disc jockey, all provided via a website in International Class 41. Citing Respondent's registration for the AFROJACKS mark, the examiner has refused registration of the AFROJACK mark in connection with the aforementioned goods and services in an Office Action dated November 16, 2013 on likelihood of confusion grounds. The application is now pending.

10. Petitioner is the owner of application Serial No. 86108588 filed on a use basis under Section 1(a) in the U.S. Patent and Trademark Office on November 1, 2013 for registration of the AFROJACK mark (stylized form) in connection with mark in connection with (i) musical sound recordings and audio-visual recordings, namely, pre-recorded phonograph records, compact discs, digital video discs, and downloadable digital audio files, all featuring music in International Class 9; and (ii) entertainment services, namely, music production, live performances by a musical performer and the playing of live and recorded music by a disc jockey; entertainment services, namely, providing downloadable and non-downloadable recorded music, non-downloadable musical videos, related video clips, photographs, tour information, event information, and other multimedia materials and entertainment information about a musical artist and disc jockey, all provided via a website. Citing Respondent's registration for the

AFROJACKS mark, the examiner has refused registration of the AFROJACK mark (stylized form) in connection with the aforementioned goods and services in an Office Action dated November 16, 2013 on likelihood of confusion grounds. The application is now pending.

11. Petitioner is the owner of application Serial No. 86108578 filed on an intent-to-use basis under Section 1(b) in the U.S. Patent and Trademark Office on November 1, 2013 for registration of the AFROJACK mark in connection with clothing, namely, shirts, pants, shorts, jackets, sweaters, T-shirts and hats, and in connection with footwear and headwear in International Class 25. Citing Respondent's registration for the AFROJACKS mark, the examiner has refused registration of the AFROJACK mark in connection with the aforementioned goods in an Office Action dated November 19, 2013 on likelihood of confusion grounds. The application is now pending.

12. Petitioner is the owner of application Serial No. 86108591 filed on an intent-to-use basis under Section 1(b) in the U.S. Patent and Trademark Office on November 1, 2013 for registration of the AFROJACK mark (stylized form) in connection with clothing, namely, shirts, pants, shorts, jackets, sweaters, T-shirts and hats, and in connection with footwear and headwear in International Class 25. Citing Respondent's registration for the AFROJACKS mark, the examiner has refused registration of the AFROJACK mark (stylized form) in connection with the aforementioned goods in an Office Action dated November 19, 2013 on likelihood of confusion grounds. The application is now pending.

13. Well prior to the issuance of U.S. Registration 3,556,451 for the AFROJACKS mark on January 6, 2009 and the June 14, 2007 dates of first use alleged therein, the Artist adopted, used and, by way of Petitioner, continues to use the AFROJACK mark in connection with music production and pre-recorded phonograph records (i.e., vinyl records) and downloadable digital audio files featuring music.

14. The Artist has produced musical sound recordings under the AFROJACK mark since at least as early as October 20, 2006, and has offered such goods, in vinyl record format and downloadable digital audio file format, through both brick and mortar music retailers and online music retailers in the United States and various other territories, under the AFROJACK mark since at least as early as November 1, 2006.

15. The Artist, both individually and by way of Petitioner, has since expanded his use of the AFROJACK mark to include use in connection with musical sound recordings and audio-visual recordings in compact disc (CD) and digital video disc (DVD) formats, live musical performances, disc jockey performances, and a website featuring the Artist's music, videos, photographs, tour information and other multimedia materials and information about the Artist.

#### **First Basis for Cancellation – Abandonment**

16. Respondent claims that it began offering its services under the AFROJACKS mark on June 14, 2007, based on Respondent's alleged first use dates in U.S. Registration 3,556,451.

17. Upon information and belief, Respondent has not made a bona fide post on its website afrojacks.com since the post dated January 22, 2012.

18. Upon information and belief, Respondent's sole use of the AFROJACK mark consisted of the afrojacks.com website which now redirects to afrojacks.co, a website consisting of content derived entirely from a third party website template complete with nonsensical placeholder text. This use amounts to nothing more than token use.

19. Upon information and belief, Respondent has established a new website afrojacksmusic.com with content consisting entirely of a place holder page. This use amounts to nothing more than token use.

20. Thus, Respondent has stopped using, with an intent not to resume, the AFROJACKS mark in connection with the services in U.S. Registration No. 3,556,451.

21. Based on Respondent's non-use, or at best token use, of its AFROJACKS mark in connection with Respondent's particular services since January 22, 2012, Respondent's intent to abandon the AFROJACKS mark can be inferred.

#### **Second Basis for Cancellation – Likelihood of Confusion**

22. There is a likelihood of confusion between Respondent's use of AFROJACKS and Petitioner's use of AFROJACK because (i) the marks are essentially identical and (ii) the services described in U.S. Registration 3,556,451 for Respondent's AFROJACKS mark and the goods and services for which Petitioner uses the AFROJACK mark are commercially related, and are likely marketed, sold and/or rendered to the same or overlapping classes of purchasers.

23. The services described in U.S. Registration 3,556,451 for Respondent's AFROJACKS mark are commercially related to the goods and services for which Petitioner uses the AFROJACK mark. Specifically, websites and blogs (or online journals) featuring audio clips, video clips, musical performances, musical videos and entertainment information featuring such multimedia materials, on the one hand, and musical sound recordings and audio-visual recordings featuring music, music production, live musical performances and the playing of live and recorded music by a disc jockey, on the other hand, are commercially related because such goods and services commonly emanate from a single source and are often sold or provided through the same channels of trade and used by the same classes of customers. Additionally, Petitioner's website featuring the Artist's music, videos, photographs, tour information and other multimedia materials and information about the Artist is essentially identical to the services for which Respondent used the AFROJACKS mark.

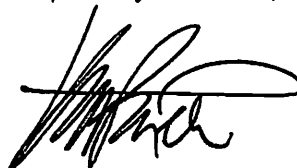
24. Purchasers are likely to be confused, mistaken or deceived into believing that the services rendered by Respondent under the AFROJACKS mark emanate from and/or are in some way affiliated with or sponsored by Petitioner when in fact they do not emanate from the same source and are not affiliated with or sponsored by Petitioner.

25. For the reasons set forth above, Petitioner is being damaged by the continued registration of the AFROJACKS mark.

26. Petitioner, therefore, petitions to cancel Registration No. 3,556,451 for the AFROJACKS mark under the provisions of Section 14 of the Lanham Trademark Act of July 15, 1946 (15 U.S.C. §1064).

WHEREFORE, Petitioner requests that judgment be entered herein canceling U.S. Registration No. 3,556,451 for the AFROJACKS mark, and for such other and further relief that may be just and proper.

Respectfully submitted,

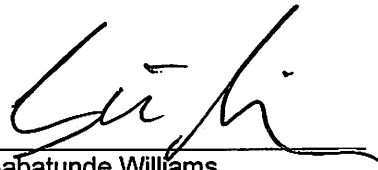


By: \_\_\_\_\_

Kurosh Nasser



By:



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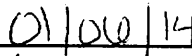
Attorneys for Petitioner

Dated: January 6, 2014

CERTIFICATE OF MAILING

I do hereby certify that the foregoing AMENDED PETITION TO CANCEL is being sent by first class mail, postage prepaid, in an envelope addressed to Leslie A. Thompson, Esq., of Leslie A. Thompson & Associates, 1629 K Street, NW, Suite 300, Washington, DC 20006 on this 6th day of January, 2014.

  
\_\_\_\_\_  
Michelle Katz

  
\_\_\_\_\_  
Date